

REMARKS

This is a full and timely response to the non-final Official Action mailed April 22, 2004 (Paper No. 04142004). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, various claims have been amended. Additionally, new claims 37-44 have been added. No claims have been cancelled by this amendment, however claims 1-19 & claims 28-31 were previously cancelled. Claims 22-27 remain withdrawn. Thus, claims 20, 21 and 32-44 are currently pending for the Examiner's consideration.

In a Restriction Requirement of March 4, 2004 (Paper No. 02242004), the Examiner made a Restriction as between the following claim groups:

(1) Claims 20-21 and 32-36, drawn to a borosilicate cylinder and related printing apparatus; and

(2) Claims 22-27 drawn to a chemical compound containing a toner.

In response, Applicant elected Claim Group 1, claims 20-21 and 32-36, but traversed the Restriction Requirement. In the recent non-final Action, the Restriction was made final. However, the arguments given in support of maintaining the Restriction were completely non-responsive to the points made by the Applicant. Consequently, Applicant again respectfully traverses the Restriction Requirement of March 4, 2004 and requests that it be reconsidered and withdrawn.

/

According to the recent Office Action, “the chemical compound containing toner particles [claims 22-27] is not in the same search field as a borosilicate cylinder containing a UV light source [claims 20-21, 32-36].” (Paper No. 02242004, p. 2). While true, this argument ignores the reality of Applicant’s claim structure.

The elected claims include claims 33-36. Claims 33-36 recite a printer having a borosilicate cylinder containing a UV light source. The recited printer also includes and uses a supply of a chemical compound containing toner particles. Thus, the subject matter recited in elected claims 33-36 includes the subject matter recited in withdrawn claims 22-27.

In order to examine elected claim 33-36, the Examiner has presumably searched both the printer having a borosilicate cylinder containing a UV light source and the chemical compound containing toner particles recited as being used in that printer. If the Examiner has not searched the claimed chemical compound, then how can claims 33-36 be rejected in the recent Office Action?

Consequently, because the subject matter of claims 22-27 has been searched during the examination of claims 33-36, there is no serious burden to apply the results of that search in an examination of the withdrawn claims 22-27. MPEP § 803 states that: “Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. (Citations omitted). **If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.**” (emphasis added). Therefore, as stated in MPEP § 803, claims 22-27 “must” be examined in this application.

Consequently, Applicant respectfully requests that the Restriction Requirement be withdrawn and that all claims be promptly examined in this application.

With regard to the prior art, claim 20 was rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,380,794 to Lawson ("Lawson"). For at least the following reasons, this rejection is respectfully traversed.

As amended herein, claim 20 recites, "A roller configured for use in a printer, said roller comprising a borosilicate cylinder comprising a UV light source therein." In contrast, Lawson teaches a UV surgical lamp that includes a hollow, borosilicate tube (18) around a bulb (14) that emits light in a range from UV to IR. Lawson does not teach or suggest the claimed roller for use in a printer comprising a borosilicate cylinder including a UV light source.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, the rejection of claim 20 based on Lawson should be reconsidered and withdrawn.

Next, claims 20, 21 and 32-36 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 4,088,552 to Morrison ("Morrison"), U.S. Patent No. 6,194,127 to Stolk ("Stolk") and U.S. Patent No. 5,888,689 to De Meutter ("Meutter"). Alternatively, claims 20, 21 and 32-36 were rejected as unpatentable under 35

U.S.C. § 103(a) over the combined teachings of Meutter and Lawson. For at least the following reasons, these rejections are respectfully traversed.

As noted above, claim 20 recites, "A roller configured for use in a printer, said roller comprising a borosilicate cylinder comprising a UV light source therein." Similarly, independent claim 32 recites:

A laser printer comprising:
a roller comprising a borosilicate cylinder comprising a UV light source disposed therein for rolling over a print medium and curing toner deposited on said print medium by said laser printer.

In contrast, none of the cited prior art references teach or suggest a roller for use in a printer that is made of a borosilicate cylinder comprising a UV light source. As described above, Lawson teaches a surgical lamp. Morrison teaches a system for recovering silver compounds. Stolk teaches a system of manufacturing patterned resistance sheets for use in electronic devices. Meutter teaches a method of producing toner images, but does not teach or suggest a roller made of a borosilicate cylinder and comprising a UV light source.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, the rejections of claims 20, 21 and 32-36 should be reconsidered and withdrawn.

Additionally, the cited prior art references do not appear to teach or suggest the details of the toner supply used in the printer of claim 32, which details are recited in claims 33-36. Again, "[t]o establish prima facie obviousness of a claimed invention, all the claim

limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." Consequently, for these additional reasons, the rejections of claims 33-36 should be reconsidered and withdrawn.

The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to independent claims 20 and 32. Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: 22 July 2004

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)